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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,732	03/29/2001	Yousuke Tanaka	0397-0424P	4354

2292 7590 10/05/2004

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EXAMINER

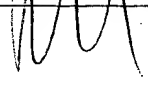
CAMPBELL, THOR S

ART UNIT	PAPER NUMBER
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3742

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/819,732	Applicant(s) TANAKA, YOUSUKE 	
	Examiner Thor S. Campbell	Art Unit 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 16, 23-25, 27, 28, 30-36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 23-25, 27, 28, 30-36 and 38-40 is/are rejected.
- 7) ☒ Claim(s) 14 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8, 11, 23-25, 27-28, 30-36, 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein (US 4399711).

Klein discloses an automated pipette including a metering pump including a cylinder having openings and a cavity, a piston inserted in the cavity, a driving source for moving the piston, and a pipette directly connected to the opening of the cylinder, wherein the pipette is disposable and detachably connected for dispensing a sample of biological fluid to be tested, further wherein the metering pump is driven by a stepper motor to advance a piston in a cylinder. It is noted that the pipette of Klein is disclosed as for use with the automated nephelometer or of US 4298570 (col. 2, lines 52-54) incorporating the teachings of Anderson et al. (US 4157871).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of JP 2-080937A.

Klein discloses the claimed invention except the cleaning fluid channel extending from the outer circumference of the cylinder. Klein discloses that after a sample is processed the pipette is washed (col. 3, line 48). JP 2080937A discloses a pipette-dispensing device having a radially extending passage for flowing cleaning fluid therethrough. It would have been obvious to one of ordinary skill in the art to modify the device of Klein to include a passageway for flowing a cleaning fluid through the dispensing device in order to eliminate contamination from one sample to the next and to further automate the process.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of JP 09133686A.

Klein discloses the claimed invention except a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit. JP 09133686A discloses a pipette-dispensing device having a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit. Klein discloses that conductivity probes could be used in place of optical sensors (col. 4, lines 33-35). It would have been obvious to one of ordinary skill in the art to modify the device of Klein to include a liquid surface detection circuit that senses the contact with the sample surface by the change in capacity of the circuit in order to provide an accurate means for sensing sample presence prior to sucking in the sample.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Kogo et al (US 4891575).

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Klein discloses the claimed invention except the analyzing section that counts the pulses due to a change in electrical impedance. Kogo discloses a particle detection system using an aperture and a current to count the pulses of impedance due to a presence or absence of cells in the circuit. It would have been obvious to one of ordinary skill in the art to modify the device of Klein to include an analyzing section as described by Kogo in order to provide an accurate count of the red or white blood cells in a sample.

Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (US 4399711).

Klein discloses an automated pipette including a metering pump including a cylinder having openings and a cavity, a piston inserted in the cavity, a driving source for moving the piston, and a pipette directly connected to the opening of the cylinder, wherein the pipette is disposable and detachably connected for dispensing a sample of biological fluid to be tested, further wherein the metering pump is driven by a stepper motor to advance a piston in a cylinder. It is noted that the pipette of Klein is disclosed as for use with the automated nephelometer or of US 4298570 (col. 2, lines 52-54) incorporating the teachings of Anderson et al. (US 4157871). Klein fails only to show the specific step interval and associated volume of the stepper motor. These specifics amount to modifications well within the skill level of the routineer and do not provide any structure to define over the prior art. discloses the claimed invention except for . It would have been an obvious matter of design choice to, since such a modification would have involved a mere change in the size of a component. The changes effectually are a change in size, such is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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Allowable Subject Matter

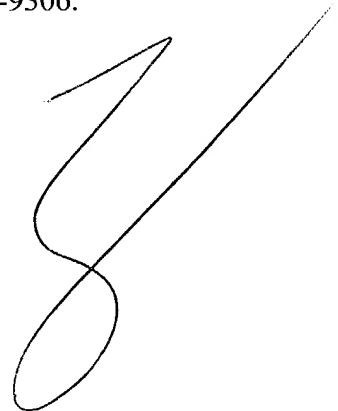
Claims 14, 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 6/30/04 have been fully considered but they are not persuasive. Applicant's arguments hinge on the definition of the word directly. It is the examiners opinion that the word directly connected does not serve to distinguish over the prior structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thor S. Campbell whose telephone number is 703-306-9042. The examiner can normally be reached on Tue-Fri 5:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans can be reached on 703-305-5766. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

A handwritten signature in black ink, consisting of a stylized, cursive 'S' or 'Z' shape with a loop at the bottom.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TSC

THOR CAMPBELL
PATENT EXAMINER

A large, stylized handwritten signature in black ink, appearing to be 'THOR CAMPBELL', is written over the printed name and title.